

# University of Strathclyde



## **Effects on Moral Rights in renting altered films and in supplying DVD altering software on-line: An analysis of the outcome of possible lawsuits in the US, UK and France**

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**Matriculation Number: 200355832**

**This dissertation is a part requirement for the LLM in Information Technology and  
Telecommunication Laws**

**Date: September 12, 2003.**

**Word Count: (20,070 approximately)**

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**Abstract:**

Companies like CleanFlick and MovieMask supply digitally altered movies on DVD / VHS and software (over the Internet) to censor / block out bad language, sex, violence and nudity respectively for private home viewing. Though the contents of the DVD / VHS remain untouched, the end result is a movie presentation that may have words replaced, scenes blocked or altered. This poses a threat to the Moral Right of the filmmaker inasmuch as it may be considered as a derogatory treatment of his / her work under some jurisdictions. These companies (MovieMask/ CleanFlick) have already been involved in a lawsuit with the Director's Guild of America in US under the Lanham Act for false attribution. The matter is sub-judice.

In this dissertation I will analyse Moral Rights in US, UK and France and predict the outcome of similar lawsuits in the US, UK and UK while also considering issues like jurisdiction and enforcement. Most of the work is based on legal precedents from US, UK, France, Australia and also the European Court of Justice.

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## 1: Introduction:

Moral rights, in civil law, are to copyright what easements are to property<sup>1</sup> – inalienable and available to the owner of the servitude property inspite of the transfer of the dominant property. Moral rights, from the eyes of a novice may be viewed as a simple non-economic right of the author. However, an in-depth study on the subject will eventually lead to the conclusion that there is more to *droit moral* than just a non-commercial interest.

The innumerable conflicts between the common law and the civil law systems come to loggerheads on the issue of moral rights in intellectual property. In this thesis I will discuss the two different approaches to intellectual property rights and how moral rights as such have been dealt with in USA, UK and France before and after signing the Berne Convention.

What effect might the failure to deal with moral rights for the digital era have on the exploitation of creative works made available over the Internet? One writer has suggested that it could mean that the laws of those territories which have the most protective moral rights regime could be applied to any work made available over the Internet<sup>2</sup> where the work is accessible in that territory. Thus the standards set by the most protective regime could be applied to the exploitation of all creative works whether or not the domestic law of the author would provide such rights.

The crux of the study will revolve around two US based companies, CleanFlicks and MovieMask, a video rental company and an on-line software retailer respectively. CleanFlick digitally edit sex, violence and bad language on legally purchased videos before writing them on CD or DVD and renting them out. MovieMask on the other hand supply software on-line that can be downloaded on a personal computer and then that software can be used to cut out the sex, violence, obscenity and bad language from a selection of movies while paying the movie.

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<sup>1</sup> AUTHORS' AND ARTISTS' MORAL RIGHTS: A COMPARATIVE LEGAL AND ECONOMIC ANALYSIS by Henry Hansmann and Marina Santilli  
<http://cyber.law.harvard.edu/property00/respect/hansmann.html>

<sup>2</sup> Gigante, "Ice Patch on the Information Superhighway: Foreign Liability for Domestically Created Content" (1996) 14 Cardozo Arts and Entertainment Law Journal

The advent of these new technologies by companies like CleanFilck and MovieMask in the US allow viewers and Video rental companies to digitally edit or censor movies. These technologies and practices have posed some very challenging questions with regard to "fair use" rights of the consumer and Moral Rights of the filmmaker respectively. CleanFlicks purchases movies on tape, and then edits out all the sex, violence, and "bad" language before renting them out to customers. The rental chain (CleanFilck<sup>3</sup>) is seeking a US court declaration that its practices are perfectly legal - and not a violation of federal copyright law, as the directors reportedly believes. Simultaneously, software is being made available to allow the viewer to "censor" the movies that they might want to watch with their children.

CleanFicks have emphasised their First Amendment Rights and have justified their actions by stating that their technology can be used for broadcasting movies on TV and for viewing movies laced with sex and violence in airplanes. Unsurprisingly, The Directors' Guild of America (DGA)<sup>4</sup> believes that what Clean Flicks is doing is far from "fair use." Indeed, it has decried the suit as an effort "to legitimise the unauthorized editing and alteration of movies." Which side is correct? Does CleanFlicks have the right to edit properly purchased movies as it sees fit before renting them out? Or does a director have the right to ensure that a movie remains edited in the ways he or she has approved?

MovieMask, the Kansas based company sells DVD-altering software online, that for now must be used with personal computers or high-end home theatre systems equipped with DVD-ROM players. In the future, MovieMask wants to install its software in gaming consoles, like the X-Box, that play DVDs. According to Breck Rice, co-founder and chief operating officer of Trilogy Studios, that own MovieMask:-

"We never alter or change the original DVD,". "So I can rent a DVD from Blockbuster or Hollywood Video, put it into my player, play it back at my own personal comfort level, take the movie out and it's the same movie that I rented. It's as if you were to put a

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<sup>3</sup> [www.cleanflicks.com](http://www.cleanflicks.com)

<sup>4</sup> "The DGA is the exclusive collective bargaining representative for more than 12,000 members of the entertainment industry, and among the DGA's members are more than 1,000 feature film directors.": Excerpts from the DIRECTORS GUILD OF AMERICA'S MOTION FOR LEAVE TO INTERVENE in Civil Action No. 02-M-1662 (MJW); can be viewed at <http://www.dga.org/NewFiles/pdfs/Motion%20to%20Intervene.pdf>

piece of cellophane over a Picasso, add color and take the cellophane off," Rice said. "It's still an unaltered Picasso."

Since the Internet has taken away the bounds of conventional geographic borders, a company located in, say, Algeria can make available such software to consumers in the EU and US. This poses multiple questions of IP rights, jurisdiction issues and enforcement issues. How far will the above statement by MovieMask be justified, in say France, where the moral rights of artistes are almost fortified? What impact will such software have on Moral Rights of the filmmakers in the UK? How far will the decision in *Gilliam v. American Broad. Co.*, 538 F.2d 14, 24 (2d Cir. 1976) (Committing false designation of origin and trademark dilution) have on the use of such software in the US?

This dissertation is almost entirely based on case laws. The objective of this paper is to predict the outcome of a litigation between the DGA and CleanFlicks / MovieMask in the US, UK and France. In the following chapters I will attempt to first explain the nature of business and the techniques applied by CleanFlicks and MovieMask. In the next chapter I will discuss the litigation that is ensuing in US between the DGA and CleanFlicks, MovieMask and others followed by a brief discussion on the evolution of Moral Rights in the US, UK and France and indeed in the digital age. Thereafter I will analyse the laws and cases relating to moral rights in US, UK and France while trying to predict the outcome of a lawsuit involving the DGA and CleanFlicks / MovieMask in the three jurisdictions.

## 2: How the flicks are cleaned:

In his Chapter I will discuss how CleanFicks and MovieMask operate

### 2.1: How CleanFlick cleans the flicks:

Based in Pleasant Grove, UT 84062, CleanFlicks is a limited liability company of Colorado. The rental chain has outlets in about 62 US cities and in as many as 14 states. The chain offers DVD / VHS on sale as well as on rental. While buying an edited movie, there are two options, A and B. A, send them your VHS or DVD, which they will edit and ship it back. This costs \$15.00 for VHS and \$18.50 for DVDs plus shipping charges. Alternatively, B, one can order a movie, which they will buy for the customer, edit it and ship it<sup>5</sup>. Buy and edit a VHS and DVD movie for \$26.95 and \$36.95 respectively, plus shipping. One can however choose to rent any of the movies from their catalogue.

In a nutshell, anyone, anywhere can buy edited movies from CleanFlicks and view them anywhere in the world. Not surprisingly the Director's Guild of the US are not too happy with this alleged assault on the moral right and creative ethics of the artistes. Here are some of the criticisms from the DGA and their sympathizers.

"We are appalled at the proliferation of companies that bypass the copyright holder and the filmmaker and arbitrarily alter the creative expression and hard work of the many artists involved in filmmaking,"<sup>6</sup>

"Imagine if Rhett Butler had intoned to Scarlett O'Hara, "Frankly, my dear, I don't give a hoot!" — or if the Sundance Kid had leaped over a cliff into the water while shouting, "Shooooooooooooooooot!" And imagine if the D-Day carnage in Saving Private Ryan were no more graphic than bullets bouncing benignly off of the sand at Normandy Beach. Imagine no more. That day is at hand."<sup>7</sup>

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<sup>5</sup> <http://www.cleanflicks.com/company/index.php?file=buy>

<sup>6</sup> DGA First Vice President Steven Soderbergh; can be viewed at [http://www.dga.org/news/v27\\_3/feat\\_editingmyfilm.php3](http://www.dga.org/news/v27_3/feat_editingmyfilm.php3)

<sup>7</sup> They're Editing My Film! By Ray Richmond at [http://www.dga.org/news/v27\\_3/feat\\_editingmyfilm.php3](http://www.dga.org/news/v27_3/feat_editingmyfilm.php3)

## 2.2: MovieMask: Unmasked

"MovieMask is going to make a difference in our family." -Larry King<sup>8</sup>

"MovieMask is a program for your PC or Laptop that allows you to watch your favourite DVD movies without exposing you and your family to the objectionable content contained in that film. Imagine letting your children watch movies such as The Matrix or Titanic without them having to see the sex, nudity, violence and language."<sup>9</sup>

According to the MovieMask website, MovieMask can be enjoyed in four easy steps: One, subscribe and install the MovieMask software. Two, insert a DVD from their "supported movie list"<sup>10</sup>. Three, select a rating level. And finally, "(s)it back and relax while MovieMask plays your version of the movie."

The MovieMask rating system defines categories of what content is allowed at each level. By selecting a rating level you are allowing all content up to your selection to be shown. Each movie will contain more or less content of the category/level you choose. Setting rating level just sets the upper limit as to what content is allowed. Contents such as language, violence and adult themes are considered yardsticks for editing. The following rating copied from their website shows just how the rating level works:-

### **"Language:**

M8: General: Only very mild language is allowed; "Quiet!" "Move!" and other such commands; light name calling like "goofball", "nut" and other playful name-calling.

M12: Teen: Slightly harsher terms such as "shut up" "jerk" "moron" "idiot" "retard" and similar terms.

M16: Young Adult: Variations of Deity as an exclamation; racial epithets, slang terms for homosexuality and similar, and strong terms for male/female anatomy.

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<sup>8</sup> Larry King is the CNN presenter of the hugely popular US TV show, Larry King Live, and he is also one of the partners of the MovieMask.

<sup>9</sup> What is MovieMask? <http://moviemask.com/what.php>

<sup>10</sup> <http://moviemask.com/library.php>



M19: Adult: Does not edit any profanity or crude language and allows the liberal use of all strong language.

**Violence:**

M8: General: Violence in this level is mostly accidental, comedic or slapstick in nature (i.e. pie-in-the-face, gags, etc...), the violence is never causing serious harm to any person or animal, only scratches or bruises, no gross/disturbing discussion or imagery, intense/scary scenes are brief.

M12: Teen: Fist fighting, wrestling, karate etc... fighting may contain the use of weapons, explosions (i.e. exploding plane, skyscraper, etc...); shooting scenes, gross topics, intense or scary scenes of any length, some blood, but not spurting/spraying/dripping from people, it is only shown "after the fact" (i.e. on their clothing after being shot or cut).

M16: Young Adult: Intense fighting and beating scenes which contain blood; (i.e. extreme sword fighting, boxing, etc...); serious cuts and bruises; shooting scenes and explosions that involve blood, no gore

M19: Adult: Shows all extreme violence; all original violent scenes from the film; which may include extreme gore, blood and mass destruction

**Adult themes:**

M8: General: Contains no nudity; no dark or adult themes discussed; no immodest clothing is shown.

M12: Teen: Implied or distorted nudity (i.e. distorted by water, behind shower glass, etc...); but are non-sexual in nature; issues like divorce or family conflict; heated arguments; slightly immodest clothing; minor sexual innuendos.

M16: Young Adult: All rear nudity and may be in sexual/sensual nature, immodest clothing; strong arguments and/or verbal abuse; discussion of abortion, drug use, rape, and other mature topics, stronger direct sexual innuendoes.

M19: Adult: May contain full frontal nudity; sex scenes; intense arguing and/or degrading verbal abuse; explicit sexual discussion.”

### 3: The litigation:

Robert Huntsman and Clean Flicks of Colorado, L.L.C., filed suit in the U.S. District Court for the district of Colorado on Thursday, August 29, 2002 naming 16 renowned directors as defendants, seeking the Court's determination as to whether their editing practices are protected under Federal Copyright law. But the government is not a party to the case, as is generally required under the First Amendment; it is the directors, not the state, who the chain anticipates will try to stop its editing practices. Accordingly, the chain's defence is derived from the First-Amendment-inspired "fair use" exception to the copyright law, and similar exceptions to related laws under which the directors can sue.<sup>11</sup>

The DGA filed an answer to the lawsuit by Robert Huntsman and CleanFlicks of Colorado, L.L.C, as well as a counterclaim to the lawsuit on September 20, 2002<sup>12</sup>. In addition, the DGA also asked the Court:

- To allow the Guild to "intervene," thereby enabling the DGA to represent the interests of its entire membership;
- To allow the Guild to expand counterclaims to include other companies that engage or contribute to the practice of editing or altering videocassettes and/or DVDs in commerce;
- To allow the Guild to bring in the motion picture studios as necessary parties, citing their role as the copyright holders of films.

#### **The counter-claim sought to include the following counter-defendants: -**

**Video II** (who edit films to offer "E-rated" video versions of new releases, which are then provided to grocery stores in Utah. Corporate record filings and previous news accounts list Glen Dickman as the President of both Video II and J.W.D. Management).

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<sup>11</sup> <http://writ.news.findlaw.com/hilden/20020903.html> THE "CLEAN FLICKS" CASE: Is It Illegal To Rent Out A Copyrighted Video After Editing It To Omit "Objectionable" Content? Tuesday, Sep. 03, 2002

<sup>12</sup> Civil Action No. 02-M-1662 (MJW) in the United States District Court for the District of Colorado. Can be viewed at <http://www.dga.org/NewFiles/pdfs/Original%20DGA%20Counterclaim.pdf>

**MovieMask**

**ClearPlay**<sup>13</sup> (like MovieMask, markets movie-filtering software that can be downloaded from the Internet. The software instructs the DVD player when to skip over or mute portions of the film in order to filter out specific content. ClearPlay is offered on a monthly paid subscription basis).

**Family Shield Technologies** (the maker of a product called MovieShield. MovieShield consists of three separate electronic devices: One device is connected between a VCR or DVD player and television set. A second device is portable and is used to transfer specific movie information. A third device is connected to a computer to download information into the transfer device. MovieShield uses a "patent pending" technology to determine which scene is being played in the movie. Then, using a database of timing information, MovieShield determines when to mute the sound and/or blank the video screen. The "shielding" is broken into eight different categories. According to their website, these categories include: "vain references to Deity; minor language; major language; nudity; sexual situations; immodesty; violence; and gore.")

**Clean Cut** (like CleanFlicks, sells, distributes, and offers, via the Internet, versions of feature films that have been edited by CleanFlicks to remove portions of the films.)

**Family Safe and** its affiliated entity **EditMyMovies** (rent and sell edited videos via the [www.familysafemedia.com](http://www.familysafemedia.com) and [www.editmymovies.com](http://www.editmymovies.com) websites. Family Safe and EditMyMovies also offer a software product called "TVGuardian," which masks or filters language of movies during their VCR playback, and provide this software in DVD players available for sale via the Internet).

**Family Flix** and its affiliated entity **Play It Clean** (sell, distribute, and offer via the Internet, versions of feature films that have been edited to remove "objectionable" portions of the films, similar to CleanFlicks.<sup>14</sup>

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<sup>13</sup> <http://www.clearplay.com/>

<sup>14</sup> Family Flix and Play It Clean offer their products via the Internet at [www.familyflix.com](http://www.familyflix.com) and [www.playitclean.com](http://www.playitclean.com).

The DGA has accused the counter defendants of violating the Lanham Act – False designation of origin<sup>15</sup> and trademark dilution. The DGA has relied heavily on the precedents laid down in *Gilliam v. American Broadcasting Co., Inc.*<sup>16</sup>, a case that will be discussed in length in following chapters, which stated that the Lanham Act “properly vindicate[s] the author’s personal right to prevent the presentation of his work to the public in a distorted form.”

It is quite noteworthy that from the above list of the extended counter-defendants, “Edit My Movies” has already stopped providing service. Their websites now contains the following message: -

“With our service provider being involved in a lawsuit with the Director's Guild of America, we are no longer offering the service of editing your movies. According to the Director's Guild, you don't have the right to have us, or our service providers, edit your movies for you.”<sup>17</sup>

Similarly, the “Clean Cut Movies” have stopped selling edited movies due to the lawsuit with the DGA. Their website now carries the following notice: -

“CleanCut Cinemas is proud to announce the renovation of the web site. Due to the current lawsuits at hand with the Director's Guild of Hollywood and the Hollywood Studios, CleanCut Cinemas was unable financially to continue fighting the fight to offer edited movies. CleanCut Cinemas will now be offering classic movies that don't need editing that the whole family will be able to enjoy.”<sup>18</sup>

I shall take up the case from here on. Since the case originates in the US, I will start with the Moral Rights in US and / or like rights that have been available to artistes / authors in the US. Then on I will try to evaluate the outcome if a similar case was to come up before an English and French court.

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<sup>15</sup> “Because the Director Counterclaimants and DGA members are inextricably associated by the public with the films they direct, Counter defendants’ unauthorized conduct violates the Lanham Act, and state law, by wrongly associating the Director Counterclaimants and other DGA members with altered versions of their films.” In page 3 under the heading of INTRODUCTION AND FACTUAL SUMMARY ; c a n b e v i e w e d a t <http://www.dga.org/NewFiles/pdfs/Original%20DGA%20Counterclaim.pdf>

<sup>16</sup> 538 F.2d 14 (1976) (US)

<sup>17</sup> <http://www.editmymovies.com/>

<sup>18</sup> [http://www.cleancutcinemas.com/pop\\_ups/coming\\_att.html](http://www.cleancutcinemas.com/pop_ups/coming_att.html)

#### **4: Historical evolution of Moral Rights:**

Moral Rights affect economic benefits attached to the creators, copyright owners and owners of physical works of art. Integrity rights, in particular, have commercial value for third parties. For example, collectors of a certain artist's work may be financially disadvantaged if this artist's work is mistreated in a way that cheapens his reputation (and thereby devalues their investment in his work), while the artist can suffer commercially in that he may receive less lucrative remuneration for future works.

Copyright in civil law is based on the presumption that the author / artist pours his mind and soul into his work, which becomes expression of his personality and as such is "subjected to the ravages of public use."

In most of Western Europe, the law has long recognized interests of authors and artists in their work that are separate from copyright and that can be retained by an author or artist even after he has transferred his copyright to another person or persons and (in the case of visual arts, such as painting or sculpture) has also parted with the physical work of art itself. Principal among these legally recognized interests are four distinct rights that are commonly referred to collectively as authors' and artists' "moral rights": the right of integrity, under which the artist can prevent alterations in his work; the right of attribution or paternity, under which the artist can insist that his work be distributed or displayed only if his name is connected with it; the right of disclosure, under which the artist can refuse to expose his work to the public before he feels it is satisfactory; and the right of retraction or withdrawal, under which the artist can withdraw his work even after it has left his hands. Most countries that recognize these rights make them, to a greater or lesser degree, inalienable.

The common-law countries on the other hand do not make explicit provision for such continuing rights of artists in their work. On the contrary they have legal precedents that effectively render as unenforceable any effort by an individual artist to craft and retain such rights in his own creations after he has transferred the other elements of ownership. Thus, patterns of rights that are mandatory under the civil-law regimes of Europe have been forbidden by the common law. This is in strong contrast to the usual relationship between these two legal systems: in general,

the common law is far more hospitable to the creation of divided property rights than is the civil law<sup>19</sup>.

Thus while there is France on one end of the spectrum where the moral rights of authors and artists are almost fortified, the US till the recent enactment of the Visual Artists Rights Act 1990 (VARA), did not recognize such rights of artists under federal laws. Though there have been state legislations for the limited protection of Moral Rights. California, for example, passed the California Art Preservation Act in 1979 giving the artist injunctive relief, damages, and attorneys' fees where his work was intentionally altered or mutilated. In 1982, California enacted additional legislation, giving the artist public standing to sue for injunctive relief to preserve or restore an altered piece, and to provide the artist a royalty at resale of the artwork. New York passed its Artist's Authorship Rights Act in 1983 that focused on the artist's right to protect his professional reputation, prohibiting the public display of an altered or mutilated work of fine art. The California Art Preservation Act did protect the destruction of "works of stature". However VARA covers only limited, fine art categories of "works of visual art" including paintings, sculptures, drawings, prints and still photographs produced for exhibition. Within this group, only single copies or signed and numbered limited editions of 200 or less are actually protected. VARA does not apply to works made for hire, posters, maps, globes or charts, technical drawings, diagrams, models, applied art, motion pictures, books and other publications, electronic publications, merchandising items or advertising, promotional, descriptive, covering, packaging material or container, nor does it cover any work not subject to general copyright protection<sup>20</sup>. The limited scope of the VARA and the UK Copyright Act 1998 while affecting "moral rights" should indicate the general attitude of indifference towards moral rights in these two jurisdictions.

Strangely enough under European and American contract law, a seller of a chattel generally cannot reserve rights in the chattel, of either an affirmative or a negative character, that are enforceable against subsequent purchasers even if those purchasers have notice of the initial seller's intention to reserve such rights. (Of course, by means of contract, a seller can retain rights against the initial purchaser, with whom he is in privity of contract.) Moral rights

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<sup>19</sup> Paul Goldstein, *Copyright's Highway, From Gutenberg to the Celestial Jukebox* 170 (1994)

<sup>20</sup> From Monty Python to Leona Hemsley: A Guide to the Visual Artists Rights Act by Cynthia Esworthy, NEA Office of General Counsel, JD Washington & Lee Law School 1997. <http://arts.endow.gov/artforms/Manage/VARA.html>

legislation changes this rule in the case of works of art, permitting the artist, in effect, to maintain a continuing negative servitude in his work, analogous to the servitudes that can be created in real property in both civil-law and common-law systems<sup>21</sup>. According to Henry Hansmann and Marina Santilli,

“The law's willingness to enforce easements, covenants, and equitable servitudes on real property, where the benefit of the servitude "touches and concerns" neighbouring property, presumably reflects (1) the potentially large advantages in coordinating the uses of parcels of property that are, by their nature, bound in a spatial relationship to each other regardless of their separate ownership, (2) the relatively low costs to the owner of the burdened parcel of remaining informed of the burden, and (3) the ease of obtaining release when that is desirable. Similarly, the few special cases in which the law permits the enforcement of servitudes on chattels--such as security interests in personal property or resale price maintenance arguably involve circumstances in which (1) unrestricted use of the burdened chattel by subsequent purchasers threatens substantial harm to the person enjoying the benefit of the servitude, (2) subsequent purchasers can easily be put on notice of the servitude, and (3) it is not too difficult for subsequent purchasers to obtain release from the servitude where appropriate. If the right of integrity can be rationalized as a reasonable exception to the general prohibition on servitudes in chattels, presumably it is because similar conditions are met. In particular, it must be true that the actions of current owners of works of art can seriously affect the interests of the artists who created those works or of other persons.”

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<sup>21</sup> See Zechariah Chafee, Jr., *Equitable Servitudes on Chattels*, 41 Harv. L. Rev. 945 (1928)



#### **4.1: Evolution of the Law in the digital age:**

The law of copyright in general has undergone dramatic transformation over the last five years. Largely in response to the fears of those at the helm of the music industry, that of seeing their content being washed away through the electronic sieve<sup>22</sup>, measures to shape copyright at the international, regional and domestic level have been hammered out. One of the earliest international treaties to address the digital age, the WIPO Copyright Treaty (WCT), set the scene for copyright and the digital agenda as early as 1996. The U.S. implementation of the obligations imposed under this Treaty followed in the form of the Digital Millennium Copyright Act (DMCA) 1998. The Europe Union enacted the Directive on the harmonisation of certain aspects of Copyright and Related Rights in the Information Society (the "Infosoc Directive")<sup>23</sup>. Three main strands or planks are discernible from this programme. The first is the move to introduce or clarify rights concerning digital dissemination of works where it was felt that existing rights did not adequately protect copyright owners or did not do so with sufficient precision. Thus in the WCT<sup>24</sup> and in the Infosoc Directive<sup>25</sup> rights concerning communication to the public and making available to the public of works on the Internet have been addressed. Secondly, within Europe at least, there is an attempt to harmonise the exceptions and limitations to copyright laws throughout the Member States. The Infosoc Directive contains an exhaustive list of these elements in the text, the majority of which the Member States have the option of incorporating into domestic law.<sup>26</sup> Finally there has been a move to validate the technical protection measures rights holders use in conjunction with the dissemination of their works over the Internet, such as anti-copying devices, and in tandem, the outlawing of the circumvention of these devices.<sup>27</sup>

However relatively little attention has been paid to the question of moral rights. The WCT merely requires signatory states to abide by Articles 2-6 of the Berne Convention. The only

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<sup>22</sup> Dommering, "Copyright Being Washed Away through the Electronic Sieve: Some Thoughts on the Impending Crisis" in *The Future of Copyright in a Digital Environment* (Hugenholtz (ed.), Kluwer, 1996)

<sup>23</sup> Directive 2001/29 of the European Parliament and of the Council of May 22, 2001 on the harmonisation of certain aspects of copyright and related rights in the information society.

<sup>24</sup> Art. 8.

<sup>25</sup> Art. 3

<sup>26</sup> It should be noticed, however, that the only mandatory exception in the text, Art. 5.1 which provides for a mandatory exception for technical or transient copies, is directly connected to the digital area

<sup>27</sup> Waelde, "The Quest for Access in the Digital Era: Copyright and the Internet" (2001) (1) *The Journal of Information, Law and Technology* (JILT) <http://elj.warwick.ac.uk/jilt/01-1/waelde.html>.

recognition of moral rights may be found in the WIPO Performances and Phonograms Treaty (WPPT) that requires the introduction (where not already enacted) of moral rights for performers concerning their live aural performances and those fixed in phonograms. Moral rights are absent from the DMCA 1998. The Infosoc Directive makes no mention of moral rights either, preferring rather to leave consideration of these to individual Member States<sup>28</sup>, apparently on the basis that moral rights will not distort the functioning of the Internal Market.

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<sup>28</sup> Recital 19

## 5: Comparative study: US, UK, France

In this chapter I will analyse the laws and case laws in US, UK and France (and partly Australia) dealing with moral rights (or like rights as in the case of US). The aim of this study is to assess the success of either the DGA or CleanFlick / MovieMask to obtain a favourable order under the three jurisdictions, namely US, UK and France.

### 5.1: United States of America: The Yankee scene

"It may be a good idea to try to incorporate some *droit d'auteur* concepts in U.S. copyright law. However, this may be a difficult, if not impossible exercise. In any case, the U.S. and Europe need a common standard for treating commercially exploitable works on the Internet. If Europe wants to be on the same level as the U.S., it will probably have to be without the author's rights paradigms. The U.S. most likely will not accept them."<sup>29</sup>

The US had reservation against signing the Berne Convention<sup>30</sup> primarily due to the moral right aspects<sup>31</sup> of the convention. In 1988, the United States reluctantly joined 78 other countries that had signed the treaty.<sup>32</sup> Simultaneously, it evaded the issue of moral rights protection with the Berne Convention Implementation Act of 1988, declaring that the Convention was not a self-executing treaty, that existing law satisfied adherence obligations, that the Berne provisions were unenforceable as a legal cause of action, and that neither adherence to the Convention nor the implementing congressional legislation either expanded or reduced any federal, state, or common law rights to claim authorship of a work or to claim injury based on any distortion, mutilation, or modification of a work. In 1990, Congress partially embraced the

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<sup>29</sup> Lehman in colloquium discussions in *The Future of Copyright in a Digital Environment* (Hugenholtz (ed.), Kluwer, 1996) p. 239.

<sup>30</sup> 1886 European Berne Convention for the Protection of Literary and Artistic Works

<sup>31</sup> Article 6bis

<sup>32</sup> History preceding VARA and expanded protections available under state laws: <http://arts.endow.gov/artforms/Manage/VARA2.html>

tenets of the Berne Convention, in passing VARA, which recognized the moral rights of attribution and integrity in the context of a limited class of visual works of art.<sup>33</sup>

US courts have long since been reluctant to recognise the concept of moral rights or authors and artists. One of the earlier cases to come up for adjudication where moral rights were denied to the artist was in 1958, an Alexander Calder black-and-white mobile was donated for placement in the Pittsburgh Airport. The Allegheny County Department of Aviation repainted the mobile green and gold, locked it into place and motorized it. Although the work was being presented in a manner contrary to the artist's intentions, Calder had no right for relief against the county government. The relief he sought was due to his moral rights, which were not protected at the time in Pennsylvania, much less anywhere else in the United States. In an earlier case, The Rutgers Presbyterian Church painted over a mural of Christ painted by Alfred Crimi because the parishioners objected to the showing of too much bare chest. No notice was given to the artist prior to the destruction of the work and Crimi lost his suit for compensatory damages<sup>34</sup>.

*Edison v. Viva Intl.*<sup>35</sup> implies that under certain circumstances an author's work may be entitled to protection. In *Edison* the court in an opinion written by Hon. Francis T. Murphy stated that while there is no moral right doctrine expressly recognized in either United States law or in the Universal Copyright Convention, "a right analogous to 'moral right' \* \* \* has been recognized in this country and in the common-law countries of the British Commonwealth—so that in at least a number of situations the integrity and reputation of an artistic creator have been protected by judicial pronouncements". The decision went on to say that the rights of the author are controlled by the terms of the contract and where the contract is silent, custom and usage will be examined to determine what rights the artist has under the contract. The contract there provided that the publisher reserved the right to edit "or otherwise change the work" as the publisher found reasonably necessary. The court held that if custom and usage limits the expression "edit and change" to "reasonable modification \* \* \* but does not allow a substantial

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<sup>33</sup> The Senate Report on the Berne Convention Implementation Act of 1988; May 20 (legislative day, M a y 1 8 ) , 1 9 8 8 ; [http://www.ipmall.info/hosted\\_resources/lipa/copyrights/The%20Senate%20Report%20on%20the%20Berne%20Convention%20Implementation.pdf](http://www.ipmall.info/hosted_resources/lipa/copyrights/The%20Senate%20Report%20on%20the%20Berne%20Convention%20Implementation.pdf)

<sup>34</sup> See more on these cases at MORAL RIGHTS SURVIVE THE SALE AND THE SOUTHERN DISTRICT; <http://www.artslaw.org/MORAL.HTM>

<sup>35</sup> (70 AD2d 379 [1st Dept 1979])

departure therefrom" then plaintiff would prevail in his claim of breach of contract based on substantial changes made in a text.

To some extent the decision in Edison (*supra*) relied upon the holding of *Preminger v Columbia Pictures Corp.*<sup>36</sup> which established the right of an owner to cut and edit so long as custom and usage so provided and as long as the artistic merit of the work, in that case the film "Anatomy of a Murder", was not impaired.

Case law interpreting section 43 of the Lanham Act (15 USC § 1125 [false designations of origin]), concluded, also protects an artist's or author's rights. In *Granz v Harris*<sup>37</sup> the Second Circuit held that publication of a truncated version of a jazz concert with the legend "Presented by Norman Granz" constituted a false attribution of authorship and hence unfair competition. The contract of sale or reproduction rights to discs had required that the legend be carried whenever the defendant sold the product.

*Carter v. Helmsley-Spear*<sup>38</sup> is useful insofar as the court reached its decision by applying VARA and interpreting some of its provisions. The court found for the defendant because the plaintiff artist's work was a work for hire, which is specifically excluded under VARA.

In *Pavia v. 1120 Avenue of the Americas Associates*<sup>39</sup> the court declared that continuing to exhibit a work of art that had been altered without the artist's consent before VARA came into effect did not infringe the artist's rights under VARA.

In another case brought under VARA, *Gegenhuber v. Hystopolis Productions, Inc.*<sup>40</sup> the court found that whatever was not expressly included in VARA could not be protected by it; specifically, the plaintiff was not entitled to the right of attribution with regard to a puppet show.

Other cases decided under state moral rights laws only tangentially looked at VARA. For example, *Lubner v. Los Angeles*<sup>41</sup> was brought under the California moral rights statute<sup>42</sup> and

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<sup>36</sup> (49 Misc 2d 363 [Sup Ct, NY County 1966, Klein, J.], *affd* 25 AD2d 830 [1st Dept 1966], *affd* 18 NY2d 659 [1966])

<sup>37</sup> (198 F2d 585 [2d Cir 1952])

<sup>38</sup> *Carter*, 71 F.3d at 82-88

<sup>39</sup> 901 F. Supp. 620, 628 (S.D.N.Y. 1995)

<sup>40</sup> No. 92-C-1055, 1992 WL 168836, \*4 (N.D. Ill. 1992). *See also* Roberta Rosenthal Kwall, *How Fine Art Fares Post VARA*, 1 MARQ. INTELL. PROP. L. REV. 1, \*38 (1997).

the court merely speculated what the outcome would be had the case been tried under VARA. Overall, federal moral rights provisions have not been tested with any degree of thoroughness in U.S. courts.

### **5.1.1: The Monty Python case:**

*Gilliam v American Broadcasting Cos.*<sup>43</sup> was the most important US case dealing with moral right like issue where the judges came closest to recognizing moral rights. To quote Circuit Judge Lumbard:

“This cause of action, which seeks redress for deformation of an artist's work, finds its roots in the continental concept of *droit moral*, or moral right, which may generally be summarized as including the right of the artist to have his work attributed to him in the form in which he created it. See 1 M. Nimmer, *supra*, at s 110.1. American copyright law, as presently written, does not recognize moral rights or provide a cause of action for their violation, since the law seeks to vindicate the economic, rather than the personal, rights of authors. Nevertheless, the economic incentive for artistic and intellectual creation that serves as the foundation for American copyright law, *Goldstein v. California*, 412 U.S. 546, 93 S.Ct. 2303, 37 L.Ed.2d 163 (1973); *Mazer v. Stein*, 347 U.S. 201, 74 S.Ct. 460, 98 L.Ed. 630 (1954), cannot be reconciled with the inability of artists to obtain relief for mutilation or misrepresentation of their work to the public on which the artists are financially dependent. Thus courts have long granted relief for misrepresentation of an artist's work by relying on theories outside the statutory law of copyright, such as contract law, *Granz v. Harris*, 198 F.2d 585 (2d Cir. 1952) (substantial cutting of original work constitutes misrepresentation), or the tort of unfair competition, *Prouty v. National Broadcasting Co.*, 26 F.Supp. 265 (D.Mass.1939). See Strauss, *The Moral Right of the Author* 128-138, in *Studies on Copyright* (1963). Although such decisions are clothed in terms of proprietary right in one's creation, they also properly vindicate the author's personal right to prevent the presentation of his work to the public in a distorted form. See *Gardella v. Log Cabin Products Co.*, 89 F.2d

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<sup>41</sup> 53 Cal. Rptr. 2d 24 (Cal. Ct. App. 1996).

<sup>42</sup> *The California Art Preservation Act*, CAL. [PROPERTY] CODE § 987(a) (West 1982 & Supp. 1995).

<sup>43</sup> (538 F.2d 14, 25 [2d Cir 1976])

891, 895-96 (2d Cir. 1937); Roeder, *The Doctrine of Moral Right*, 53 *Harv.L.Rev.* 554, 568 (1940).”

The court held that the offering by ABC of a mutilated version of a work (the Monty Python series) constituted a false designation of origin which "impaired the integrity of appellants' work and represented to the public as the product of the appellants what was actually a mere caricature of their talents."

However, as Pinover<sup>44</sup> points out, it is worth noting that despite the court's rhetoric about moral rights, the decision was made on economic grounds: "Although the court speaks of harm to Monty Python's reputation, it uses the commercial terms of lost profits and success. The artistic work is a product and one has a duty not to falsely represent its origin."

In deed contrast a similar suit brought about by Jacob Jaeger arising from the English version of an alleged garbled and distorted German film failed before the District Court for the Southern District of New York<sup>45</sup>. In the instant case the plaintiff alleged he directed and co-authored the script for "Kamasutra – Vollendung der Liebe" (Kamasutra- the Perfection of Love) in 1968. In 1971 the defendants purportedly started exhibiting a distorted and mutilated version of the film, the rights to which the defendants had lawfully obtained. To quote Judge Frankel, "Around October 1<sup>st</sup>, plaintiff claim AIP began exhibiting a version of the film 'from which major parts of the picture as originally produced in Germany have been eliminated and in which a segment of approximately 25 minutes in length has been inserted resulting in gross distortion and mutilation of the original screenplay\*\*\*'. Since this is being done without his consent, plaintiff claims that 'the attribution to him of mutilated and pornographically altered motion picture' violates his 'right of literary property'. These rights, as they are recognized in American decisions, are similar, but not identical, to the 'moral rights' of authors that are, plaintiff asserts. 'widely recognized in Civil law countries.' He seeks injunctive relief under this first count"

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<sup>44</sup> See Diana Elzey Pinover, *The Rights of Authors, Artists and Performers Under Section 43(a) of the Lanham Act*, 83 *TMR* 38 (1993) (providing an overview of the Lanham Act in relation to attribution and integrity, as well as case law).

<sup>45</sup> Jacob JAEGER, Plaintiff, v. AMERICAN INTERNATIONAL PICTURES, INC., Defendant No. 70 Civ. 5688 UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK 330 F. Supp. 274; 1971 U.S. Dist. LEXIS 14235; 169 U.S.P.Q. (BNA) 668

Even though the Lanham Act<sup>46</sup> deals with trademarks rather than copyright, it was successfully used to prevent American Broadcasting Corporation from infringing the moral rights of Monty Python. So will the DGA's resorting to similar offensive against MovieMask and CleanFlick yield the same result?<sup>47</sup>

### 5.1.2: The assessment:

While there are a few similarities between the cases, the differences in the facts and circumstances are quite wide. While ABC had broadcast the mutilated versions of Monty Python on national television, CleanFlick rents edited tapes for private viewing. MovieMask on the other hand simply sells the software that may be used to edit bits and parts of the movie. In any case the target of the so-called editing is bad language, violence, nudity and sexual depictions that are considered unsuitable for children. US courts have traditionally favoured shielding young children from bad language and sexual depictions. See for example FCC v. Pacifica Foundation<sup>48</sup> where the Supreme Court took extreme exceptions against vulgar, offensive and shocking broadcasts on radio even though such sanctions were reserved for "indecent broadcasting".

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<sup>46</sup> 15 U.S.C. § 1125(a) (1994). The relevant provisions for the purpose of this paper are in Section 1125 (false designations of origin, false descriptions, and dilution forbidden):

(a) Civil action.

| Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which –

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

<sup>47</sup> supra note 10.

<sup>48</sup> 438 U.S. 726 (1978)



Second, it is quite evident that the movies edited by CleanFlick or MovieMask are not the original one and therefore any intentional trademark dilution may be ruled out for certainly all viewers are expecting slight modifications on the edited versions. After all these companies make money by making clear to the public that their annotations are different from what Hollywood is producing. It makes little business sense for them to hide the origins of their annotations. Furthermore, companies like Movie Mask and CleanFlick are providing entirely independent annotations, so it is very unclear how one can get customer confusion out of that.<sup>49</sup>

Third, MovieMask's software allows its users to view an absolutely unedited version of the movie under the M19 rating. Therefore MovieMask's position is quite similar to that of Grokster<sup>50</sup> inasmuch MovieMask does not directly involve in any infringement and its software has lawful uses as well.

As the firm principle of jurisprudence stands – “When interpreting a statute, we look at the language first”<sup>51</sup>. Therefore if moral right protection to film makers are explicitly ruled out of VARA it is evident that Congress had no intention whatsoever to extend moral rights to films. Due to the uniquely pervasive presence of movies in homes children are more likely to be confronted with the vulgarity, nudity or bad languages that some movies contain in their own living rooms. Therefore any efforts by parents to edit out such unsuitable material will find favour in the First Amendment protection going by the decision of the US Supreme Court in *Red Lion Broadcasting Co. v. FCC*<sup>52</sup> and in the *FCC v. Pacifica Foundation* (as discussed above) where the court has favoured that patently obscene though not indecent expression of opinion should at least be regulated in terms of channelling behaviour rather than prohibiting them.

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<sup>49</sup> The Hypocrisies of the Writers Guild of America, West by [Ernest Miller](http://research.yale.edu/lawmeme/modules.php?name=News&file=article&sid=410) on Tuesday, October 15 @ 02:07:48 EDT at <http://research.yale.edu/lawmeme/modules.php?name=News&file=article&sid=410>

<sup>50</sup> METRO-GOLDWYN-MAYER STUDIOS, INC., et al., Plaintiffs, v. GROKSTER, LTD., et al., Defendants. JERRY LIEBER, et al., Plaintiffs, v. CONSUMER EMPOWERMENT BV a/k/a FASTTRACK, et al., Defendants. AND RELATED COUNTERCLAIMS CV 01-08541-SVW (PJWx), CV 01-09923-SVW (PJWx) UNITED STATES DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA 2003 U.S. Dist. LEXIS 6994 April 25, 2003, Decided

<sup>51</sup> *Richardson v. United States*, 119 S.Ct. 1707, 1710 (1999).

<sup>52</sup> *US Supreme Court*, 395 U.S.. 367

At this point we can simply wait and watch how the judges view the CleanFlick case. Though going by precedents and available copyright laws and First Amendment defences, it is more likely the judges will favour CleanFlicks and MovieMask.

## 5.2: United Kingdom:

Copyright law has evolved with technology. The first copyright statute, the Statute of Anne, was enacted in Britain in 1710 with the advent of more efficient copying technology like the printing press. The British Parliament enacted the Statute of Anne that instituted the right to prevent the copying of newly authored books for fourteen years from publication. However, this Act only applied to printed works leaving artistic and theatrical works to be governed by other enactments.

Moral rights did not appear in U.K. legislation before the adoption of the Copyright Designs and Patents Act (CDPA) 1988<sup>53</sup> but, at common law, courts used the general laws of defamation<sup>54</sup>, passing off<sup>55</sup> or injurious falsehood to find some, albeit limited, redress for litigants. The appearance of moral rights in CDPA 1988 only occurred as a result of the ratification by the United Kingdom of the provisions of Article 6bis of the Berne Convention adopted in 1928<sup>56</sup> but made compulsory in 1948<sup>57</sup>.

The U.K. has broader moral rights provisions than the U.S. For one, moral rights pertain to authors of literary, dramatic, musical or artistic works, as well as to directors of a film<sup>58</sup>. However, there are two major concerns with U.K. moral rights provisions: the formality requirement under section 78, and the myriad limitations and exceptions to moral rights.

Let us first consider the requirement for the author to formally assert his right of attribution. The right of attribution is fundamental to moral rights. Attribution also gives the most economic benefit to the author. After all, the name of an author or artist carries an intangible yet important economic benefit of goodwill, and therefore his ability to earn an income from his future work depends to a large degree on the recognition of his name. Thus, the moral right of attribution is vital to an author's economic prosperity and, along with the right to object to

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<sup>53</sup> The right of integrity came into force on August 1, 1989.

<sup>54</sup> *Humphreys v. Thompson* [1905-1910] Mac. C.C. 148

<sup>55</sup> *Samuelson v. Producers Distributing* [1932] 1 Ch. 201

<sup>56</sup> Berne Convention, Rome version (1928).

<sup>57</sup> Berne Convention, Brussels version (1948).

<sup>58</sup> Sec 77(1) of the Copyright, Design and Patents Act, 1988

derogatory treatment, is his most important prerogative. Yet U.K. moral rights provisions are designed to put the onus of establishing attribution on the author.<sup>59</sup> Specifically,

□

“[t]he author of a copyright literary, dramatic, musical or artistic work, and the director of a copyright film, has the right to be identified as the author or director of the work in the circumstances mentioned in this section; but the right is not infringed unless it has been asserted in accordance with section 78”.<sup>60</sup>

□

Section 78 (1) of the CDPA further provides:

□

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

□

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

Moreover, there are numerous exceptions to the right of attribution. Certain works are exempt, including computer programs and computer-generated work<sup>61</sup>, and works whose copyright is vested in the employer<sup>62</sup>. Authors cannot claim the right when the work in question has been used in accordance with the provisions in section 79(4), whereby one of the most notable

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<sup>59</sup> Most books published in the U.K. after the moral rights provisions took effect carry a statement asserting the author’s moral rights. Presumably, the author has no right to attribution if he has neglected to assert this right (of course, in this case he could resort to trade practices law, defamation law, or other relevant law).

<sup>60</sup> Copyright, Design and Patents Act, at s.77

<sup>61</sup> at s.79(2)

<sup>62</sup> at s.79(3).

provisions regards fair dealing. Perhaps the most far-reaching exceptions (i.e., those with significant economic impact) are found in section 79(6), which states:

□

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

(a) a newspaper, magazine or similar periodical, or

(b) an encyclopedia, dictionary, yearbook or other collective work of reference, of a literary, dramatic, musical or artistic work made for the purposes of such publication or made available with the consent of the author for the purposes of such publication.”

□

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

The exception to the right of attribution flows on to the right to object to derogatory treatment.<sup>63</sup> The exceptions to the right to object to derogatory treatment are outlined and they apply to the same range of publications as the exceptions to the right of attribution. Combined, the exceptions to the right of attribution and to the right to object to derogatory treatment can severely affect not only reputation, but also earning power and the author’s ability to attract new employers, commissioners, and purchasers of his work.

Section 79(4) provides that the right of attribution is not infringed when something done in relation to the work would not otherwise infringe the copyright, such as fair dealing. This exception is similar to the U.S. law, where fair use of an artistic work is permitted.<sup>64</sup> A somewhat arresting provision is that estoppel can be applied to justify exceptions to moral rights. Section 87(4) reads that “[n]othing in this Chapter [on moral rights] shall be construed as excluding the operation of the general law of contract *or estoppel in relation to an informal*

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<sup>63</sup> at s.80.

<sup>64</sup> 17 U.S.C. § 107 (1991).

*waiver* or other transaction in relation to any of the rights mentioned in subsection (1)” Essentially, this gives the potential infringer a wide variety of defenses, while providing the author with a set of narrowly defined rights. It is somewhat perplexing that an author can waive his moral rights informally, but needs to assert them formally. In fact, it is difficult to see how U.K. moral rights provisions significantly contribute to the existing rights of authors under other statutory and common law.

The main purpose of statutory protection is to avoid the need to incorporate moral rights in a contract, thereby relieving the artist of having to negotiate these rights for himself, usually with a party with more bargaining power. The U.K. case study once more demonstrates the reluctance of common law countries to embrace moral rights fully and shows the apprehension with which legal practitioners view these rights. Till 1998 there had been no reported case on Moral Rights in the UK.<sup>65</sup>

The Withford Committee was set up in 1972 under the Chairmanship of Mr Justice Withford to review the Copyright Act of 1956 under the light of technological advancement which had prompted the revision of the Berne Convention in Stockholm in 1967 and in Paris in 1971. The said committee drew attention to the economic justification of copyright vis-à-vis the public interest.

“Unless something is done there is a serious danger that, in some fields at least, publication will cease. We can envisage a vicious circle: the increase in library and other copying means smaller circulations; which means higher costs; which in its turn means more copying. In the end publication ceases. And that, clearly, would not be in the public interest.”

Another aspect that needs to be considered while focusing on the moral rights of authors in UK is the impact of the Human Rights Act, 1998. In the tug-of-war between copyright and freedom of expression, it will be a very close contested battle between the film makers right of integrity, a right only recently recognized in UK against the freedom of expression guaranteed by Article

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<sup>65</sup> Mike Holderness, *Moral Rights and Authors' Rights: The Key to the Information Age*, 1 THE J. OF INF. L. & TECH. (1998) (reporting that as of 1998 there is no U.K. case law on moral rights), available at [http://elj.warwick.ac.uk/jilt/infosoc/98\\_1hold/contentf.htm](http://elj.warwick.ac.uk/jilt/infosoc/98_1hold/contentf.htm).

10 of the European Convention of Human Rights<sup>66</sup>. Two cases, which provide significant analysis of this tug-o-war, are (a) *Newspaper Licensing Agency Ltd. V. Marks & Spencer plc.*<sup>67</sup> and (b) the *Ashdown case*<sup>68</sup>

A significant aspect of the CDPA is that in order to qualify for an infringement of moral rights, the edited film must be issued to the public.

“77.—(1) The author of a copyright literary, dramatic, musical or artistic work, and the director of a copyright film, has the right to be identified as the author or director of the work in the circumstances mentioned in this section; but the right is not infringed unless it has been asserted in accordance with section 78.

(2) The author of a literary work (other than words intended to be sung or spoken with music) or a dramatic work has the right to be identified whenever—

(a) the work is published commercially, performed in public, broadcast or included in a cable programme service; or

(b) copies of a film or sound recording including the work are issued to the public; and that right includes the right to be identified whenever any of those events occur in relation to an adaptation of the work as the author of the work from which the adaptation was made.”<sup>69</sup>

Similarly,

(4) The author of an artistic work has the right to be identified whenever—

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<sup>66</sup>1 “Everyone has the right to freedom of expression. this right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers. This article shall not prevent States from requiring the licensing of broadcasting, television or cinema enterprises.

2 The exercise of these freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society, in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or the rights of others, for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary”

<sup>67</sup> [2001] R.P.C 76, CA House of Lords [2001] E.C.D.R 28

<sup>68</sup> *Ashdown v Telegraph Group Ltd* [2001] EWCA Civ 1142, [2002] QB 546

<sup>69</sup> Sec 77 CDPA

- [(a)] the work is published commercially or exhibited in public, or a visual image of it is broadcast or included in a cable programme service;
- [(b)] a film including a visual image of the work is shown in public or copies of such a film are issued to the public; or
- [(c)] in the case of a work of architecture in the form of a building or a model for a building, a sculpture or a work of artistic craftsmanship, copies of a graphic work representing it, or of a photograph of it, are issued to the public.<sup>70</sup>

As far as the right to object to derogatory treatment of a film goes, CDPA stipulates that:-

“80.—(1) The author of a copyright literary, dramatic, musical or artistic work, and the director of a copyright film, has the right in the circumstances mentioned in this section not to have his work subjected to derogatory treatment.

[(2)] For the purposes of this section—

[(a)] "treatment" of a work means any ***addition to, deletion from or alteration*** (stress added) to or adaptation of the work, other than—

- [(i)] a translation of a literary or dramatic work, or
- [(ii)] an arrangement or transcription of a musical work involving no more than a change of key or register; and

[(b)] the treatment of a work is derogatory if it amounts to distortion or mutilation of the work or is otherwise prejudicial to the honour or reputation of the author or director; and in the following provisions of this section references to a derogatory treatment of a work shall be construed accordingly.

[(3)] In the case of a literary, dramatic or musical work the right is infringed by a person who—

- [(a)] publishes commercially, performs in public, broadcasts or includes in a cable programme service a derogatory treatment of the work; or
- [(b)] issues to the public copies of a film or sound recording of, or including, a derogatory treatment of the work<sup>71</sup>

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<sup>70</sup> Sec 77 (4) CDPA

<sup>71</sup> Sec 80 CDPA dealing with *Right to object to derogatory treatment of work*



Sub section 6 of Section 80 further provide that:

“(6) In the case of a film, the right is infringed by a person who—

[(a)] shows in public, broadcasts or includes in a cable programme service a derogatory treatment of the film; or

[(b)] ***issues to the public copies of a derogatory treatment of the film***, (stress added)

or who, along with the film, plays in public, broadcasts or includes in a cable programme service, or issues to the public copies of, a derogatory treatment of the film sound-track.”

### 5.2.1: Case studies:

So what are the chances CleanFlick and Moviemask stand in a possible litigation by the DGA claiming infringement of Moral Rights before English Courts?

Though admittedly, none of the two “shows in public, broadcasts or includes in a cable programme service a derogatory treatment of the film”. Prima facie, CleanFlick stands a great chance of being hit by sections 77 and 80. Since CleanFlicks sells / rents the edited movies on DVD and / or VHS format, they will clearly be hit by Section 80(2) for deleting and altering the copies of the original movie and thereafter issuing to the public copies of a derogatory treatment of the films in contravention of Sec 80 (6).

MoveiMask on the other hand do not delete nor alter copies of the films for sale or rent nor do they “distribute copies” of the films. They simple supply software that may be used to alter a movie for private viewing. They have a further defence in the principles laid down in the Leyland case<sup>72</sup> where it was held that:

“The principle proposed by Armstrong is as follows: fair dealings between a copyright owner who makes and markets machinery and the consumers who buy it include the

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<sup>72</sup> BRITISH LEYLAND MOTOR CORPORATION LTD. AND ANOTHER RESPONDENTS AND ARMSTRONG PATENTS CO. LTD. AND ANOTHER APPELLANTS [HOUSE OF LORDS] [1986] AC 577

facility of access to a stock of spare parts made by other manufacturers so that availability and price competition is assured, and protection is afforded to the manufacturer who provides that stock provided he uses only the minimum amount of copying necessary to make the spare part fit. This would amount to a fair use of the copyright. Armstrong agreed that this principle amounts to the proposition that the spare part manufacturer has an implied licence. But public policy requires this. It cannot be right that the original manufacturer can have a monopoly in respect of the manufacture of spare parts for his machine.”

Therefore an analogous argument may be made that on similar grounds, a consumer has the right to alter snippets of a film to suit his / her sensitivity.

Given that CleanFlick intends to defend their actions under the First Amendment (similar to the UK right to freedom of expression) CleanFlick can seek defence under the freedom of expression guaranteed under the UK Human Rights Act, 1998. Namely,

- “12. - (1) This section applies if a court is considering whether to grant any relief which, if granted, might affect the exercise of the Convention right to freedom of expression.
- (2) If the person against whom the application for relief is made ("the respondent") is neither present nor represented, no such relief is to be granted unless the court is satisfied-
- (a) that the applicant has taken all practicable steps to notify the respondent; or
- (b) that there are compelling reasons why the respondent should not be notified.
- (3) No such relief is to be granted so as to restrain publication before trial unless the court is satisfied that the applicant is likely to establish that publication should not be allowed.
- (4) The court must have particular regard to the importance of the Convention right to freedom of expression and, where the proceedings relate to material which the respondent claims, or which appears to the court, to be journalistic, literary or artistic material (or to conduct connected with such material), to-
- the extent to which-
- (i) the material has, or is about to, become available to the public; or
- (ii) it is, or would be, in the public interest for the material to be published;
- any relevant privacy code.

(5) In this section-

"court" includes a tribunal; and

"relief" includes any remedy or order (other than in criminal proceedings).<sup>73</sup>

And,

"1. Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers. This Article shall not prevent States from requiring the licensing of broadcasting, television or cinema enterprises.

2. The exercise of these freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society, in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or rights of others, for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary."<sup>74</sup>

CleanFlick can also seek defense under the public interest defence to breach of copyright in section 171(3) of the 1988 Act, namely,

"171.—(1) Nothing in this Part affects—

(a) any right or privilege of any person under any enactment (except where the enactment is expressly repealed, amended or modified by this Act);

(b) any right or privilege of the Crown subsisting otherwise than under an enactment;

(c) any right or privilege of either House of Parliament;

(d) the right of the Crown or any person deriving title from the Crown to sell, use or otherwise deal with articles forfeited under the laws relating to customs and excise;

(e) the operation of any rule of equity relating to breaches of trust or confidence.

(2) Subject to those savings, no copyright or right in the nature of copyright shall subsist otherwise than by virtue of this Part or some other enactment in that behalf.

(3) ***Nothing in this Part affects any rule of law preventing or restricting the***

<sup>73</sup> Sec 12 of the Human Rights Act, 1998.

<sup>74</sup> Schedule 1, Part I, article 10 (Freedom of Expression)

***enforcement of copyright, on grounds of public interest or otherwise.*** (stress added)

“(4) Nothing in this Part affects any right of action or other remedy, whether civil or criminal, available otherwise than under this Part in respect of acts infringing any of the rights conferred by Chapter IV (moral rights).

“(5) The savings in subsection (1) have effect subject to section 164(4) and section 166(7) (copyright in Acts, Measures and Bills: exclusion of other rights in the nature of copyright).”

#### **5.2.1.1: The Ashdown Principle:**

However, the principles laid down in the Ashdown case may prevent these endeavours to cloak the apparent departure from the CPDA on the grounds of the right of freedom expression. In the Ashdown case the Court (Court of Appeal) had to decide whether copyright law restricts the right to freedom of expression more than necessary in democratic society and whether facts of individual cases had to be examined to assess whether protection of freedom of expression requiring additional defences. The Headnote of the instant case reads as follows:

“The claimant had kept diaries while he was the leader of a major political party, with a view to later publication. After he relinquished the leadership he prepared the material for publication and showed it in strictest confidence to representatives of the press and publishing houses. Included in the material was a minute of a particularly important political meeting in October 1997. A copy of the minute reached the political editor of the defendant's newspaper, which published articles about it on 28 November 1999, quoting verbatim from a substantial part of the minute. The claimant brought an action against the defendant claiming breach of confidence and copyright infringement and seeking injunctions and damages or an account of profits. His application for summary judgment in respect of the copyright claim was resisted on the grounds that, when considering whether an actionable breach of copyright had occurred or the remedies appropriate in the event of such a breach, the court should have regard to the right of freedom of expression conferred by article 10 of the European Convention for the Protection of Human Rights and Fundamental Freedoms, as scheduled to the Human

Rights Act 1998 n1, which required the court to give individual consideration to the facts of each case in order to assess the impact of article 10. The judge granted the claimant's application for summary judgment on the basis that the defendant had no real prospect of successfully defending the action, and there was no other compelling reason for that part of the claim to go to trial.

On appeal by the defendant it was held that:

“(1) that, although section 12 of the Human Rights Act 1998 did not require the court to place extra weight on the matters concerning freedom of expression to which subsection (4) referred but merely underlined the need to have regard to the contexts in which European human rights jurisprudence had given particular weight to freedom of expression, rare circumstances could arise where the right of freedom of expression came into conflict with the protection afforded by the Copyright, Designs and Patents Act 1988 notwithstanding the express exceptions in that Act; that in those circumstances the court was bound so far as possible to apply the 1988 Act in a manner that accommodated the right of freedom of expression, which made it necessary for the court to look closely at the facts of individual cases; and that in most cases it would be sufficient simply to decline the discretionary relief of an injunction while recognising that, if a newspaper considered it necessary to copy the exact words created by another, it should in principle indemnify the author for any loss caused to him or account to him for any profit made as a result of copying his work (post, paras 27, 45-46).

(2) That the circumstances in which the public interest defence to breach of copyright in section 171(3) of the 1988 Act might override copyright were not capable of precise categorisation or definition; that since the coming into force of the Human Rights Act 1998 there was the clearest public interest in giving effect to the right of freedom of expression in those rare cases where it trumped the rights conferred by the 1988 Act; and that, while section 171(3) of the 1988 Act therefore permitted the defence of public interest to be raised, it would be rare for the public interest to justify copying the form of a copyright work rather than the information contained within it.”

The Court held that “It must follow that intellectual property rights constitute a restriction on the right of freedom of expression”. It therefore follows that the Freedom of Expression under the Human Rights Act and the rights under the CPDA have their own limitations. To apply the test which right should prevail in the event of a conflict between these rights, the Court held that the liabilities imposed by the CPDA would limit the extent of the right of freedom of expression a citizen has under the Human Rights Act. Though this case did not deal with Moral Rights in particular yet the broad principles laid down may be sufficient to destroy the US First Amendment-like defence for altering copyright protected movies in the UK and thereafter issuing the altered versions to the public. In a nutshell, if the CPDA lays down that distributing altered copies of copyright films is a violation of moral rights of the film maker, a defence of freedom of expression for such act may not succeed as the said freedom is statutorily curtailed by the restrictions imposed by the CPDA.

#### **5.2.1.2: Fair dealing defence:**

As far as the defence of fair dealing is concerned, regard may be had of *Hubbard v Vosper*<sup>75</sup>, where it was held “Fair dealing is a matter of fact, degree and impression”. The most important factors which require to be taken into account when determining whether the defence is made out are (i) whether the alleged fair dealing is in commercial competition with the owner's exploitation of the work, (ii) whether the work has already been published or otherwise exposed to the public and (iii) the amount of work which has been taken and the importance of that which has been taken.<sup>76</sup>

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<sup>75</sup> see [1972] 2 QB 84

<sup>76</sup> see Laddie, Prescott & Vitoria, *The Modern law of Copyright and Designs*, 3rd ed (2000), para 20.16.

### 5.2.1.3: Pasterfield v Denham

The only reported case in UK dealing with Section 80 of the CDPA (the right to object to a derogatory treatment) has been *Pasterfield v Denham and another*<sup>77</sup> where the plaintiff brought proceedings against the defendants for infringement of copyright, infringement of moral rights and passing off. It was held that in respect of the alleged infringement of the plaintiff's moral rights, it was for plaintiff to establish that the treatment accorded to his work had been a distortion or mutilation, which had prejudiced its honour or reputation as an artist for the purposes of section 80 of the CDPA Act, it was not sufficient that P was aggrieved by the treatment of his work. In the instant case, the amendments to the drawings were so trivial that they could not amount to derogatory treatment and, accordingly, the allegation was dismissed. It was also held that the passing of equitable title in copyright or the grant of an implied licence to use a copyright work did not mean that an author had waived his or her moral rights within the meaning of section 87 of the CPDA.

Going by the above precedents I would conclude that in the event of litigation the balance of favour would slide towards the DGA.

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<sup>77</sup> PLYMOUTH COUNTY COURT [1999] FSR 168, (1998) IP & T Digest 29; 10 MARCH 1998

### 5.3: France: the forte of droit moral

Though the concept of moral rights of authors developed in France in the last quarter of the 19<sup>th</sup> and early 20<sup>th</sup> century, the notion of "author's rights" existed in France since 1777.<sup>78</sup> Recognition that authors had certain rights dates from around that time although such rights, as they had, were transferred to the bookseller under a contract to print and publish. France, having one of the most significant cinema-going markets outside of the United States<sup>79</sup>, also has the distinction of offering probably one of the most onerous and protective copyright and authors' rights regimes in the world. The level of protection given to copyright authors in France is partly explained by the fact that French copyright law draws a fundamental distinction between the freely assignable economic rights of the author (*droits patrimoniaux*) (e.g. the right to authorise the reproduction, use and performance of a work) and the personal, non-waivable and inalienable moral rights of the author (*droits moraux*) which will remain vested in the author during his life and thereafter will be transmitted to the heirs. One of the most striking features of the artists moral rights under French law is the right of withdrawal, (*droit de repentir et de retrait*), the most infrequently used of the moral rights, this right offers the author the option to withdraw his work from the public provided always that the assignee of exploitation rights to the work is fully compensated for the loss arising from the exercise of such right<sup>80</sup>.

Another distinct feature of moral right infringement is that the infringer may be sued upon as either criminal offences<sup>81</sup> or civil torts, at the option of the infringed party. In the former case, it is important to stress that copyright infringement in general may be the subject of criminal proceedings issued either by the State prosecution office following complaint by the infringed party or by the commencement of a private prosecution (*citation directe*) though, in reality, criminal breaches of moral rights are rarely prosecuted and are almost without exception the subject of civil claims based upon the general "common law" liability for tort under Article 1382

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<sup>78</sup> Copyright and the Public Interest by Gillian Davies (Sweet & Maxell, 2002)

<sup>79</sup> 165.54 million entries for 2000 representing 5847 million FF in ticket sales of which 62.2 per cent U.S. productions--source Centre National de Cinématographie.

<sup>80</sup> Art. L121-4 "Notwithstanding the assignment of his economic rights in respect of any work, the author, even following the publication of his work, enjoys a right to withdraw the same from the assignee. He may only however exercise such right subject to the prior compensation of the assignee in respect of the loss incurred by the latter by such withdrawal."

<sup>81</sup> Articles L335-2 et seq. provide for criminal infringement liable to maximum penalties of two years imprisonment and a fine of 1 million FF (or equivalent Euros)



of the Civil Code.<sup>82</sup> These moral rights have been strengthened by years of judicial decision in favour of artists or authors who have claimed infringement of moral rights. I will discuss a few cases and the various rights that have been regarded as rock solid. Thereafter I will analyse a prospective CleanFlick and / or MovieMask v. DGA type litigation before French Courts in the backdrop of the following case laws and the peculiar French laws of moral rights.

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<sup>82</sup> Art. 1382 CC: "Any wrong committed howsoever by man which causes loss to others will require the person or persons through the fault of which such loss was caused to compensate the same."

### 5.3.1: Case laws under the French Court:

In this part I will analyse the views of the French Courts regarding different aspects of Moral Rights and jurisdictions. I will also compare some US decisions with the French ones.

#### 5.3.1.1: Inalienable:

Article L121-1 of the Code<sup>83</sup>, which defines the moral rights, states (translated in English)

"Art. L121-1 The author enjoys the right to respectful treatment of his name, of his authorship and of his work.

This right is a personal right. Such right is perpetual, unassignable and not subject to any limitation.

Such right is transmitted upon death to the heirs of the author.

The exercise of such right may be conferred upon a third party by testamentary provision."

Being inalienable in nature, moral rights in France create an almost perpetual proprietary right of the authors and artists in their work. In a recent case, the Supreme Court in Paris ruled on a contract in which an author agreed that a work should be modified as necessary to be used for advertising purposes and settled the principle against an advance waiver of the author's integrity right. The Supreme Court censured any type of advance and generalised assignment whilst providing for a degree of discretion in the case of specifically worded contractual provisions<sup>84</sup>. In their judgment dated January 28, 2003, the Supreme Court criticised the position taken by the Paris Court of Appeal with respect to the conditions governing the exercise of authors' moral rights. In a notable decision of June 28, 2000, the Paris Court of Appeal had held that a clause expressly authorising use of a work for advertising purposes together with the modifications necessary to such use and given in consideration of a freely negotiated and accepted payment amounted to an "advance exercise" of moral rights and not a

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<sup>83</sup> French Intellectual Property Code

<sup>84</sup> FRANCE: MORAL RIGHTS - SUPREME COURT ESTABLISHES INALIENABLE NATURE OF MORAL RIGHTS: Entertainment Law Review 2003

waiver. The Supreme Court emphasised the inalienable nature of the integrity right "such right operating to prevent any advance and generalised abandonment by an author in favour of an assignee, of the exclusive right to determine, in its sole discretion, the various uses, dissemination, adaptation, withdrawal, adjunction and changes to which a work may be put". The Supreme Court censured any type of advance and generalised assignment whilst providing for a degree of discretion in the case of specifically worded contractual provisions.

Similarly in an earlier decision dated January 22, 2203, the High Court of Nanterre adjudicated on the legality of contracts with music libraries with respect to moral rights<sup>85</sup>, the Court held, that the publisher's exemption from the requirement to obtain written consent prior to any audio-visual synchronization of works falling within the category of production music libraries should be interpreted as a contractually imposed limitation of limited scope granted by the author and not as an advance waiver of exercise of the author's moral rights.

### **5.3.1.2: Droit de Divulgation:**

In the Francis Picabia case<sup>86</sup>, the well renowned artist being highly disappointed in a painting tore it up and threw it away. However, a neighbour, undoubtedly fully aware and appreciative of the notoriety of the artist, recovered the painting from the garbage, restored it, touched it up with some paint and placed it in his home. When the artist discovered this, he sued the neighbour under the moral public communication right (*droit de divulgation*) in order to recover the painting. Though the defendant pleaded to the effect that the painting was garbage (*res derelictae*), the legal title to which was transferred to him under French property law, he was ordered to give way to the prevailing artist's moral right over his work thus enabling the artist to take possession of the painting so as to destroy it more effectively.

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<sup>85</sup> Art.L132-12 of the French Intellectual Property Code requiring publishers to ensure the continuous exploitation and commercial dissemination of works in accordance with industry practices.

<sup>86</sup> Francis Picabia, Cass 1<sup>er</sup> Civ, December 17, 1971

Similarly in *Re Colette Granier de Cassagnac and Others*<sup>87</sup> the painter, Cassagnac while living as a tenant of the defendant, tied up some sketches that he did not consider worth exhibiting and dumped them in the attic. After the painter vacated the premises, the defendant landlady discovered the abandoned sketches and tried to sell them in the market. The artist sued claiming derogatory treatment of his work. The landlady defended her actions based on property laws. The court, unsurprisingly, favoured the painter. The Court held that the decision to disclose the author's work, which has the effect of taking it out of the private domain and making it available to the public, can only be made by the author or by his heirs after his death; the violation of that moral right of distribution granted to the author constitutes an offence assimilated to the counterfeiting of works; in the present case the abandonment of the works in a cellar by the painter, who had cut them from their frames and rolled them up, revealed his intention not to put them on the market, an intention which he consistently reaffirmed from 1982 onwards, considering that they were unfinished and imperfect and had also been retouched and over-painted by other persons.

The above two cases are markedly different in facts and circumstances from the *Cleanflick v. DGA* issue in that CleanFlick are issuing to the public altered copies of movies that the filmmaker has all intentions to keep in the public domain. Yet, it is worth noting the Court condemned the retouching and over painting of the sketches by other artists and took cognisance of these facts while making their judgement.

### **5.3.1.3: Joint authorship:**

Firstly, a cinematographic work is classified under French law as the joint work (*oeuvre de collaboration*) of its contributing authors and in respect of which separate copyright will subsist in each contribution. Such class of copyright work compares starkly with collective works (*oeuvres collectives*) created under the initiative of the person who publishes and divulges the

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<sup>87</sup> Before the French Cour de Cassation, Chambre Criminelle (Supreme Court, Criminal Chamber) Cass (F) ( The President M. Le Gunehec, Mme Ferrari, MM Simon, Aldebert, Grapiner, Judges) 13 December 1995 Appeal from the Cour d'Appel, (Court of Appeal), Paris.

same to the public under its direction and in its name and in whom the exercise of copyright will be vested. This is distinctly different from the US view on co-authorship of movies.

The US case of *Aalmuhammed v. Lee*<sup>88</sup> analysed the qualifications for co-authorship of a film and the question, who, in the absence of a contract can be considered as author of a movie. The Court relied in the Supreme Court's definition of author in the famous photography case involving Oscar Wilde<sup>89</sup> where the Supreme Court decided that the photographer was the author, quoting various English authorities: "the person who has superintended the arrangement, who has actually formed the picture by putting the persons in position, and arranging the place where the people are to be - the man who is the effective cause of that"; "'author' involves originating, making, producing, as the inventive or master mind, the thing which is to be protected"; "the man who really represents, creates, or gives effect to the idea, fancy, or imagination."<sup>90</sup> The Court said that an "author," in the sense that the Founding Fathers used the term in the Constitution<sup>91</sup>, was "he to whom anything owes its origin; originator; maker; one who completes a work of science or literature.". In *Lee v. Aalmuhammed* the Court was of the opinion that "Control in many cases will be the most important factor". The Court held that in the absence of a contract or an intention to the contrary, the author of a film would be the person to whom the work owes its origin and who superintended the whole work, the "master mind". Authorship, according to the US Courts is not the same thing as making a valuable and copyrightable contribution.

Secondly, as joint works, the French Code goes on to specify the persons deemed to be contributing joint authors to cinematographic works providing that:

"Art. L113-7 The natural person(s) responsible for the intellectual creation in an audio-visual work is or are the author(s) of such audio-visual work. The following are presumed to be co-authors of an audio-visual work, unless the contrary can be proved:

The author of the screenplay;

The author of the adaptation;

The author of the script;

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<sup>88</sup> 202 F.3d 1227 (9th Cir. 2000) Before: William C. CANBY, Jr., John T. NOONAN, and Andrew J. KLEINFELD, Circuit Judges. [http://www.law.cornell.edu/copyright/cases/202\\_F3d\\_1227.htm](http://www.law.cornell.edu/copyright/cases/202_F3d_1227.htm)

<sup>89</sup> *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 61 (1884).

<sup>90</sup> Quoting *Nottage v. Jackson*, 11 Q. B. D. 627 (1883).

<sup>91</sup> U.S. Const. Art. 1, § 8, cl. 8.

The author of musical compositions with or without lyrics specifically produced for the work;

The director.”

As specifically concerns screen adaptations of previously existing works, Article L113-7 specifically provides that the original author (or screenwriter) will be treated as a joint author of the new audio-visual work:

“Art. L113-7: Where the audio-visual work is drawn from a pre-existing work or screenplay still subject to protection, the authors of the original work will be treated as authors of the new work.”

Each of the above persons will accordingly be effectively treated as owning a fragmented copyright subsisting within a film together with corresponding exercisable moral rights.

Thirdly, even though there may be several joint authors to an audio-visual work, the Code will effectively limit the right of any contributing author to impede the use of their contribution in order to prevent the completion of the work.

#### **5.3.1.4: The entitlement of non-French rights holders to sue--the Reciprocal Treatment Rule:**

The French-domiciled authors or authors of works divulged in France benefit from the rights conferred under the Code together with the various rights available to its joint authors (which, in the case of a remake or television adaptation will include the original author). Non-French authors of non-French divulged works (like the members of the DGA) assigns contractual rights between producers and screenwriters and directors whereby the producer takes a full assignment of copyright and all other rights subsisting in the work. It would appear clear, at least in principle, that assignor authors will have no basis upon which to sue in breach of copyright in default of breach by the producer of the terms of such agreement. In jurisdictions such as the U.S. in which authors' moral rights are not recognised, such assignment would therefore defeat any potential claims by the author. But, as described above, to the extent that the authorship is recognised in favour of any person and notwithstanding any prior assignment

of copyright to the producer, the French courts will entertain claims alleging a breach of moral rights of a non-French copyright work where the loss flowing from such breach takes place within the jurisdiction of the French court upto the extent the claimant can prove they are the rightful legal beneficiaries of the moral rights to the work.

Article 111-4 paragraph 1 of the Code in principle subjects the extension of the benefit of protection accorded by French copyright law to a non-French work for sufficient and effective protection accorded by the state in which such work was divulged for the first time<sup>92</sup>.

Prior to the United States signing the Berne Convention, the French Courts applied the Reciprocal Treatment Rule that appeared to deprive a work divulged by its author (in the case of a film, the director) in the United States of the benefit of any action founded upon a breach of the author's moral rights. This was on the basis that the lawfulness of waivers of moral rights under the U.S. Copyright Law fell foul of the Reciprocal Treatment Rule.

Article 111-4 paragraph 2 of the Code specifically exempts moral rights from the scope of the Reciprocal Treatment Rule by providing that "no violation may be made to either integrity or the paternity of such works".

### **5.3.1.5: The Huston Case**

Following the Supreme Court decision of 1991 involving the U.S. director, John Huston<sup>93</sup> such exemption of moral rights from the Reciprocal Treatment Rule is now well established. In the Huston case, the heirs of the U.S. director issued proceedings in France to prevent the broadcast by a French television channel of a coloured version of the black and white film "Asphalt Jungle" (1950) co-directed by Huston. The plaintiffs claimed that the colouring of the film, carried out by the rights owner without the consent of the heirs as custodian of the moral

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<sup>92</sup> Art. L111-4: "Without prejudice to the provisions of international treaties to which France is a signatory, where, following consultation of the Minister of Foreign Affairs, it is found that a State does not offer to copyright works divulged for the first time in France in whatever form a sufficient and effective level of protection, copyright works divulged for the first time on the territory of such state may not benefit from the protection afforded in respect of copyright under French laws."

<sup>93</sup> Civ 1, May 28, 1991: Bull civ 1, n. 172--Consorts Huston and ors v. Turner Entertainment CO and ors.

rights of the director, amounted to a violation of the integrity right of the director. The lower Court of Appeal had dismissed the Huston's claim on the basis that any injunction would have had the effect of setting aside both applicable U.S. law and the contracts entered into between the original studio and the directors under which the studio was assigned the full copyright in the picture and as a consequence of which the studio (and thereafter its assignee) was deemed first author. In considering this case, the Paris Appeals Court faced a situation similar to that which was raised in the earlier case of Rowe.<sup>94</sup> In that case, Rowe had claimed for infringement of his moral rights (integrity and paternity) after Walt Disney Productions had produced and exploited an animation film entitled "The Aristocats". This was based on an original idea of Rowe's, who had assigned his rights to the work (initially intended to be produced with live animals) under English law. First, the Paris Appeals Court insisted both in Rowe and in Huston that "the legal certainty of contracts would be destroyed if a party were allowed to ignore obligations entered into under the law of a specific country by availing itself of the contrasting law of another country". Secondly, both decisions refused to treat the question of moral rights of the author as a matter of public policy, which would have imposed the application of French law. The Court considered that "this concept of French public policy can be applied only with the greatest degree of precaution" and that it could not be associated with "injuries which foreign citizens, especially minors, could endure, outside the scope of any contract, in application of customs which our civilisation condemns as infringing the most sacred elements of human beings, such as physical integrity or matrimonial freedom"<sup>95</sup>. The Supreme Court, in considering the issue of recourse to French moral rights by the estate of a foreign author to prevent the public disclosure (in this case broadcasting) of an allegedly derogatory treatment of the audio-visual work, the French courts had to deal with some factual oddities under the French droit d'auteur texts. Indeed, Turner Entertainment Co. invoked its position as the author of the movie under U.S. law. By stark contrast, French law does not allow for a non-physical person to be considered as the author of a protected work. Thus, the first conflict, which arose between French and American law, was as to the position of the author. The essential point of the debate revolved around this: if John Huston was not to be considered as the author of the film, he could not invoke the benefit of the moral rights since they are attached to his sole person. A second conflict arose between the two systems at stake: could the moral rights granted by French law enable authors to circumvent in part the

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<sup>94</sup> Rowe c. Société Walt Disney Productions et autres Paris, February 6, 1986, (1989) I J.C.P. 3376 and [1987] F.S.R. 36.

<sup>95</sup> Rowe c. Société Walt Disney Productions et autres Paris, February 6, 1986, (1989) I J.C.P. 3376 and [1987] F.S.R. 36



effect of an assignation which was valid in the country of origin? The Supreme Court preferred the solutions adopted in the cases of *Société Roy Export et Charlie Chaplin c. Société Les Films Roger Richebé* (concerning the film *The Kid*)<sup>96</sup> and *Anne Bragance*<sup>97</sup>. The Supreme Court, specifically citing the exemption provided in Article 111-4 paragraph 2 of the Code, overturned the Court of Appeal decision stating not only that the lower court had failed to apply Article 111-4 paragraph 2 of the Code but also that these provisions were of mandatory application in all cases as a matter of French public policy by sole virtue of the legal entitlement of an author to the protection of his integrity and paternity right and irrespective of the state in which the work was first divulged.

The basis for recognition by the French courts of the rights of U.S. authors is now facilitated by the adhesion of the United States to the Berne Convention. Accordingly, the author or the legitimate heirs of the paternity and integrity moral rights to a motion picture first divulged outside of France would be entitled to sue before the French courts in respect of any claimed breach of such rights.<sup>98</sup>

Going by the above French precedents set that deal with the highly protected moral rights and noting that these rights will also be extended to US citizens for movies made in the US, it appears that the DGA has a fair chance of success. However, as will be seen from the Victor Hugo case (discussed in Chapter 7), the DGA may not have a locus standi to sue in France. More so since moral rights are not transferable there is no way the DGA can sue on behalf of its members. If, however, the filmmakers themselves brought the litigation before the French courts, the position will favour the filmmakers.

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<sup>96</sup> Paris, April 29, 1959, (1959) II J.C.P. 11134. The facts of this case were different but the decision admitted the right for a foreign citizen to benefit from the protection of moral rights in France

<sup>97</sup> Paris, February 1, 1989, D. 1989. Somm. 90.

<sup>98</sup> FRANCE: MORAL RIGHTS - SUPREME COURT ESTABLISHES INALIENABLE NATURE OF MORAL RIGHTS: Entertainment Law Review 2003

## 6: Jurisdiction:

The Internet, it is said, makes territorial borders redundant<sup>99</sup>. Information in digitised form of pictures, text, music, photographs and software can all be seamlessly disseminated from one side of the globe to the other. There is (almost) nothing to stop these works from being uploaded, made available, communicated, distributed and finally downloaded anywhere in the world. Despite the emergence of decisions intended to give a more territorial character to the contents posted on the Internet<sup>100</sup>, borders, whether physical or psychological, do not (at present) seem to exist for the users. The effect of this absence of borders is that in many areas of law acute questions arise over matters of jurisdiction and, notably, choice of law. In the event of a dispute concerning artefacts made available on a website considered illegal in one country but not in another, exactly which courts should have jurisdiction to hear the dispute, and whose law should be applied to determine the illegality? Where a programmer on one side of the world writes a program that contravenes the laws applicable within the borders of a territory on the other side of the world, which law should determine the liability of that programmer?<sup>101</sup> When one electronic newspaper publishes an article potentially defamatory of an individual on the other side of the world, which courts should hear the disputes and which standards should determine the liability of the newspaper?<sup>102</sup>

What if the DGA pursues to take CleanFlicks and / or MovieMask to courts in the United Kingdom or France as the Moral Right protection in these jurisdictions appear to be prima facie more severe than the United States? Will they have jurisdiction in UK or France? Can the orders of a British or French court be enforceable against CleanFlicks or MovieMask?

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<sup>99</sup> Johnson and Post, "Law And Borders--The Rise of Law in Cyberspace" (1996) 48 Stanford Law Review 1367

<sup>100</sup> League against racism and anti-Semitism (LICRA) French Union of Jewish Students v. Yahoo! Inc (USA) Yahoo! France Tribunal de Grande Instance de Paris November 20, 2000. Comment at [2001] 1(3) Electronic Business Law Reports 110-120.

<sup>101</sup> US v. Sklyarov. For a full and informative account of this case see [http://www.eff.org/IP/DMCA/US\\_v\\_Sklyarov/us\\_v\\_sklyarov\\_faq.html](http://www.eff.org/IP/DMCA/US_v_Sklyarov/us_v_sklyarov_faq.html).

<sup>102</sup> Gutnick v. Dow Jones & Co. Inc. [2001] V.S.C. 305 (August 28, 2001).

## 6.1: The ECJ Decision in *Shevill v. Press Alliance*

The question at the basis of *Shevill v. Press Alliance*<sup>103</sup> was one of competence of courts in a cross-border wrongdoing. *Shevill* concerned defamation but nonetheless is instructive for this discussion for two reasons: first, it concerns different jurisdictions, namely France and England. Secondly, interesting comments are made in the case relating to the place of harm for cross-border delict cases.

The facts of the case were that in 1989 an issue of the newspaper *France Soir*, published by a French company, contained an article with comments about an individual resident in England, a company registered in Yorkshire, a company registered in France and a company registered in Belgium. The article contained defamatory material. An action was raised in England for damages in respect of copies of the newspaper distributed in England and Wales. An application was sought to have the case struck out on the grounds that the French courts alone had jurisdiction as the newspaper was domiciled in France. It was argued that Article 5(3) of the Brussels Convention was irrelevant because as the matter related to tort, delict or quasi delict, the English courts did not have jurisdiction; that section related to "the place where the harmful event occurred"; the harmful event in this case (being the publication of the newspaper), it was argued, had occurred in France.

The ECJ was asked for a preliminary ruling on two broad issues. First, for guidance on the interpretation of the phrase "the place where the harmful event occurred" to establish which court had jurisdiction where a defamatory statement was distributed in several states. The solution given by the ECJ followed the principle laid down in the 1976 case of *Handelskwekerij G J Bier BV v. Mines de Potasse d'Alsace SA*<sup>104</sup>. The Court considered that action could be brought "... against the publisher either before the courts of the contracting state where the publisher of the defamatory publication is established, which have jurisdiction to award damages for all the harm caused by the defamation, or before the courts of each contracting state in which the publication was distributed and where the victim claims to have

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<sup>103</sup> Case C-68/93 *Shevill and Others v. Press Alliance* [1995] 2 W.L.R. 499

<sup>104</sup> Case C-21/76 *Handelskwekerij G J Bier BV v. Mines de Potasse d'Alsace SA* [1976] E.C.R. 1735

suffered injury to his reputation, which have jurisdiction to rule solely in respect of the harm caused in the state of the court seised".

Combining the Shevill and the Huston decisions it may be apparent that the European judges determined that it should only be for the national judges to assess whether harm had been done by applying their own "substantive law determined by the[ir] national conflict of law rules". In consequence, it seems that the author who finds a software (on the Internet) capable of altering this protected work could see in French courts the ideal forum for action, even though he can seek redress only for that part of the harm suffered in France. As we have seen above with the Huston case, the French Supreme Court (Cour de Cassation) considers that the French rules on moral rights are of mandatory application. In determining the question of rules of mandatory application, it has been said in relation to French procedure that: "... when facing an international private law problem, the judge has first to consider whether his own law is of mandatory application and if, as a matter of fact, it necessarily requires to be directly applied to the facts of the case. If the answer is positive, there is no need to search further. In the opposite case, recourse has to be made to the conflict of laws traditional method. This latter method thus only comes into play after the possibility for the application of a law of mandatory application has been raised."<sup>105</sup>. As the ECJ in Shevill said that reference had to be made to the national conflict of law rules of the court seised, French courts will apply their own moral right laws as they are of mandatory application.

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<sup>105</sup> Loussouarn et Bourel, *Precis Dalloz de Droit International Privé* (3rd ed.)

## 7: Locus Standi:

In a recent case<sup>106</sup>, Victor Hugo's grandchildren claimed compensation for the alleged infringement of their grandfather's Moral Rights. The Paris High Court in a decision dated September 12, 2001 held that at the end of his life, the author had designated a poet friend as custodian of his rights. In default of the plaintiff demonstrating the necessary locus standi to sue as his grandfather's heir, the moral rights action was dismissed. The Court furthermore refused the voluntary joinder to the action of the literary association, la Société des Gens de Lettres de France (SGL), on the grounds that only the legal heirs of the author, in the absence of legatee, could exercise the integrity right over a work post mortem auctoris. Unable to show that Victor Hugo had bequeathed any rights to it, the SGL's action was dismissed.

As discussed earlier, France treats moral rights as unassignable and inalienable. Thus the DGA will probably not have any Locus Standi to sue on behalf of the directors it represents before French courts, as the right holders of the films the two defendants allegedly alter, have not assigned their Moral Rights to the DGA.

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<sup>106</sup> Hugo v Plon SA (Unreported, September 12, 2001) (Trib Gde Inst (Paris)) (France)

## 8: Place of “publication”: the Dow Jones principle

CleanFilks has rental outlets and physically ships out the edited DVDs and Videotapes from its various outlets. These physical good, namely DVD and VHS are delivered to the buyers doorstep. Thus it will not be too difficult to establish the place where the cause of action arises. It will be either where the movies are shipped from or where they are shipped. MovieMask is owned by Trilogy Studios, based in the US but the product being an on-line software, it may raise a question where the alleged offending software is being “published”. The Australian decision in the Dow Jones case<sup>107</sup> may be of help in answering this question. The basic facts of the Dow Jones case is quoted herein below from paragraph 169 of the judgement:

“The appellant publishes for profit the *Wall Street Journal*, a daily financial newspaper, and *Barron's*, a weekly magazine, which is also concerned with financial matters. The edition of *Barron's* dated Monday, 30 October 2000, but which was available publicly two days earlier, contained an article by a journalist working for the appellant, Bill Alpert, headed "Unholy Gains" and sub-headed "When stock promoters cross paths with religious charities, investors had best be on guard." A large photograph of the respondent appeared on the first page of the magazine. The article, of about 7,000 words, also contained photographs of other persons including Mr Nachum Goldberg. *Barron's* has a large circulation in the United States. Altogether, it was likely that 305,563 copies of the magazine were sold. A small number of them entered Australia, some of which were sold in Victoria. *Barron's* also put the article on the Internet. The relevant article appeared on the appellant's website on 29 October 2000. Subscribers who paid an annual fee were able to obtain access to that site at its address wsj.com. The site had about 550,000 subscribers. The appellant has an office that it calls a "corporate campus" in New Jersey where it has a web server on which its website is stored. It was conceded by the appellant that it could not identify the addresses of all of its subscribers but that 1,700 or so of them paid subscription fees by credit cards whose holders had Australian addresses.”

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<sup>107</sup> Dow Jones & Company Inc v Gutnick [2002] HCA 56 (10 December 2002) before the High Court of Australia

The respondent was involved with some religious groups in Australia. He was instrumental in collecting charity for various religious organisations. He felt his reputation was deeply injured due to the slanderous attack on his business- religious nexus. The respondent had first raised action before the Supreme Court of Victoria claiming damages and asserting that though the appellant was controlled from the US, the website may be deemed to be published in Australia on the following grounds:-

"The publication of the article in Victoria ... was the intended consequence, alternatively the natural and probable consequence of the following acts of the [appellant] -

- (a) securing subscriptions to its wsj.com and Barron's Online websites from persons resident within Victoria;
- (b) writing the article or causing the article to be written;
- (c) editing the article;
- (d) formatting the article into a web page file for Barron's Online;
- (e) transferring the file containing the article from New York to the [appellant's] server in South Brunswick, New Jersey;
- (f) placing the file containing the article onto the [appellant's] web servers in New Jersey;
- (g) creating links to the article (both direct and indirect) on the wsj.com and Barron's Online websites; and
- (h) thereby making the article available for downloading in Victoria by the [appellant's] subscribers from time to time to the wsj.com and Barron's Online websites."<sup>108</sup>

The Supreme Court of Victoria ruled in favour of Gutnick (the respondent before the High Court). Dow Jones appealed before the High Court of Australia. The High Court dismissed the appeal and held that the respondent was entitled to damages. However the most unique aspect of the High Court judgement lies in it's ruling that the place of publication was indeed Victoria, where the defamatory material was downloaded. The High Court finally held that:

"I agree with the respondent's submission that what the appellant seeks to do, is to impose upon Australian residents for the purposes of this and many other cases, an American legal hegemony in relation to Internet publications. The consequence, if the

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<sup>108</sup> Quoted from paragraph 175 of the High Court judgement

appellant's submission were to be accepted would be to confer upon one country, and one notably more benevolent to the commercial and other media than this one, an effective domain over the law of defamation, to the financial advantage of publishers in the United States, and the serious disadvantage of those unfortunate enough to be reputationally damaged outside the United States. A further consequence might be to place commercial publishers in this country at a disadvantage to commercial publishers in the United States.”<sup>109</sup>

Though this principle is now established in the publishing industry, will it be applicable to copyright infringement? The answer is in the affirmative. In the same High Court judgement, the Court has held that:

“There is another relevant consideration. The law of defamation has some elements in common with the law of injurious falsehood, copyright and contempt.”

This final analogy between the laws of defamation and copyright is might be found to be more crucial in the US jurisprudence since moral right like issues have been treated under defamation and trademark dilution in contrast to copyright infringement.

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<sup>109</sup> Paragraph 200 of the Judgement



## 9: Enforcement of overseas judgments: the Yahoo! Saga

The French courts have already had several opportunities to address this issue in disputes involving unlawful content placed online outside of the jurisdiction but accessible from within France. Although the arsenal of legal tools available under French and community laws would appear sufficient to tackle such problems, the various solutions adopted by the courts to date have generated inconsistency, even if certain recent noteworthy decisions do evidence an increasingly harmonious approach to the matter.

Article 46 of the French Civil Procedure Code, the Nouveau Code de la Procédure Civile lays the foundation for the jurisdiction of the French courts in civil matters provides that, in civil matters, a plaintiff may "seize at his option, in addition to (a) the courts of the place of residence of the defendant [...] either (b) the courts of the place of the occurrence of the tortuous act or (c) those within the jurisdiction of which the loss was suffered".

Assuming that the DGA does succeed in getting a favourable order before a French Court how far will this French order be enforceable on MovieMask or CleanFlick? This hypothetical scenario will be very similar to the Yahoo case<sup>110</sup> involving the auction of Nazi memorabilia on the Yahoo! website in France.

Yahoo Inc. operated a number of web sites, including an auction site and search engine directory at Yahoo.com and a number of regional sites like Yahoo.co.uk (UK), Yahoo.co.in (India) and Yahoo.fr. The sites operated at Yahoo.com are written in English, while the site operated at Yahoo.fr is written in French.

Various third parties posted for sale on Yahoo's auction site Nazi-related propaganda and Third Reich related memorabilia, including Adolf Hitler's "Mein Kampf" and "The Protocol of the Elders of Zion" (an infamous Anti-Semitic report). In April, 2000 defendant, La Ligue Contre Le Racism Et L'Antisemitisme ("LICRA")<sup>111</sup>, a non-profit organization dedicated to eliminating Anti-Semitism, sent a 'cease and desist' letter to Yahoo, informing Yahoo that the advertisement

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<sup>110</sup> Yahoo! Inc v La Ligue Contre le Racisme et l'Antisemitisme 169 F. Supp. 2d 1181 (2001)

<sup>111</sup> The League Against Racism and Anti-Semitism

and/or sale to French residents of Nazi and Third Reich related goods through Yahoo's auction site violated French law. When Yahoo! Failed to comply with the Notice, the LICRA took Yahoo Inc. to court in France. The French court found that approximately one thousand Nazi and Third Reich related materials were offered for sale on Yahoo.com's auction site. As French citizens could access these auctions via links on Yahoo.fr, the French Court concluded that Yahoo.com's auction site violated section R645-1 of the French Criminal Code, which prohibits the exhibition of Nazi propaganda and artefacts for sale. As a result, the French court issued an order requiring Yahoo Inc to:-

“(1) Eliminate French citizens' access to any material on the Yahoo.com auction site that offers for sale any Nazi objects, relics, insignia, emblems, and flags; (2) eliminate French citizens' access to web pages on Yahoo.com displaying text, extracts, or quotations from Mein Kampf and the Protocol of the Elders of Zion; (3) post a warning to French citizens on Yahoo.fr that any search through Yahoo.com may lead to sites containing material prohibited by Section R645-1 of the French Criminal Code, and that such viewing of the prohibited material may result in legal action against the Internet user; (4) remove from all browser directories accessible in the French Republic index headings entitled "negationists" and from all hypertext links the equation of "negationists" under the heading "Holocaust." The order subjects Yahoo! to a penalty of 100,000 Euro for each day it fails to comply with the order.”

The order concludes: "We order the Company YAHOO! Inc. to take all necessary measures to dissuade and render impossible any access via Yahoo.com to the Nazi artefacts auction service and to any other site or service that may be construed as constituting an apology for Nazism or a contesting of Nazi crimes."

The French court reaffirmed this order on November 20, 2000, despite Yahoo's contentions that compliance with the French Order was technologically impossible. The French court directed Yahoo to comply with its order within three months, or face a penalty of 100,000 francs (approximately U.S. \$13,300) per day.

Yahoo defended its actions under the panacea of the US First Amendment, claiming such order on part of the French Court was against the freedom of expression in US. Yahoo thereafter commenced an action in the United States District Court for the Northern District of California, seeking a declaratory judgment that the French Order could not be enforced in the

United States under the laws of the United States. On Yahoo's motion for summary judgment, the court, as explained more fully below, granted Yahoo's motion.

The District Court framed the following issues: -

“What is at issue here is whether it is consistent with the Constitution and laws of the United States for another nation to regulate speech by a United States resident within the United States on the basis that such speech can be accessed by Internet users in that nation. ... There is little doubt that Internet users in the United States routinely engage in speech that violates, for example, China's laws against religious expression, the laws of various nations against advocacy of gender equality or homosexuality, or even the United Kingdom's restrictions on freedom of the press. If the government or another party in one of these sovereign nations were to seek enforcement of such laws against Yahoo! or another U.S.-based Internet service provider, what principles should guide the court's analysis.”

After deciding that this question must be answered by application of United States law, the court held the enforcement of the French Order would run afoul of the First Amendment. The French Order, prohibiting the sale of Nazi related items, is a content based restriction that "a United States court constitutionally could not make...". As recognized by the Court "the First Amendment does not permit the government to engage in viewpoint-based regulation of speech absent a compelling governmental interest, such as averting a clear and present danger of imminent violence" which compelling interest was not present in this case.

The French Order further ran afoul of the First Amendment because it was impermissibly vague insofar as it directed Yahoo to "take all necessary measures to dissuade and render impossible any access via Yahoo.com to the Nazi artefact auction service and to any other site or service that may be construed as constituting an apology for Nazism or a contesting of Nazi crimes...". Lastly, the Court determined it was not obligated, under principles of comity, to enforce the French Order given its conflict with the important United States policy considerations reflected in the First Amendment. The Court finally held that:

“The French Order's content and viewpoint-based regulation of the web pages and auction site on Yahoo.com, while entitled to great deference as an articulation of French law, clearly would be inconsistent with the First Amendment if mandated by a court in the United States. What makes this case uniquely challenging is that the

Internet in effect allows one to speak in more than one place at the same time. Although France has the sovereign right to regulate what speech is permissible in France, this Court may not enforce a foreign order that violates the protections of the United States Constitution by chilling protected speech that occurs simultaneously within our borders.”

The Court accordingly declared the French Order unenforceable in the United States.

The Huston case and the Yahoo! Case read together does create a dichotomy of sorts. While the former dealt with moral rights the latter involved unlawful publication. However it is worth noting that the US First Amendment can be successfully applied as a defence in both the cases. While the Huston case was enforceable in the US, the Yahoo! case was directly hit by the First Amendment defence and fell shy of enforcement in the US.

In the Corley case<sup>112</sup> the Judges have already affirmed that ncomputer code (program) is speech and so being it will be afforded the full protection of the First Amendment in the US. Though it should be submitted, in the Corley case which challenged the constitutionality of the DMCA, the Judges held that the DeCSS (the software at issue) being a Computer Code and Computer Programs, qualified as “free speech” under the First Amendment, but the instant arguments of the appellants failed the content-based test for qualifying as free speech. Instead the Judges considered that the Code (DeCSS) was a functional based speech and therefore out with the protection of the First Amendment.

Keeping the above precedents in view, even if French Court could pass an order against MovieMagic, MovieMagic has a slim chance of avoiding enforcement in the US claiming (on the same grounds as Yahoo!) that its software was a speech and therefore entitled to First Amendment protection.

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<sup>112</sup> UNIVERSAL CITY STUDIOS, INC. and others v. ERIC CORLEY, also known as Emmanuel Goldstein, and 2600 ENTERPRISES INC., UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT. 273 F.3d 429; 2001 U.S.

## **10: Conclusion:**

Having traversed the legal position in three continents and scrutinised the subjects of moral rights, freedom of expression and jurisdiction under a metamorphic microscope it is safe to conclude that the CleanFlick and MovieMask issues pose more serious legal questions than it appears to the naked eye.

On one hand it is apparent that CleanFlick and MovieMask do not alter the contents of DVD but simply superficially edit content that are considered appalling to the sensibilities of many movie viewers. Such practice is not too uncommon – it is used in airplanes and definitely in jurisdiction with archaic censorship laws. On the other hand it is true that blacking out ten minutes of the part where the boat with the US soldiers reach the shores of Normandy in Saving Private Ryan drain out almost the entire dramatic effect that Spielberg intended to portray.

While the First Amendment may protect such altering practices, yet it will cry foul in France while British judges will have a very trying time indeed under similar circumstances. Then comes the open ended questions of jurisdiction and enforcement. Though DGA may receive a favourable decision in France it may not be easy to enforce the French Court's order in the US. All in all it will be overwhelmingly interesting to observe the outcome of the US courts in Colorado in the actual suit pending between the DGA and CleanFlick. We can just wait and watch and let time prove whether the legal analysis and predictions I have drawn up of the two hypothetical lawsuits and the one pending before the US Court prove me right or wrong.

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